REMARKS

Claims 1-34 remain in the application for consideration. In view of the following remarks, Applicant traverses the Office's rejections and respectfully requests that the application be forwarded on to issuance.

Telephone Communications

The Applicant acknowledges a telephonic interview conducted with the Examiner on June 14, 2006, and a follow-up call from the Examiner on June 19, 2006. The Applicant appreciates the Examiner's time in this regard as well as the cooperative direction of these communications.

In accordance with the telephonic interview of June 14, 2006 the Applicant understands that claims 4-6, 9-10, 19-22 and 27-34 are rejected only under 35 U.S.C. § 101, and are thus not otherwise rejected. Accordingly, the Applicant believes that claims 4-6, 9-10, 19-22 and 27-34 are allowable if the corresponding rejection under § 101 is overcome.

Drawing Objections

The drawings stand objected to in the Office Action Summary. In accordance with the Examiner's follow-up call of June 19, 2006 cited above, the Applicant understands that Figs. 1, 2, and 6 are objected to as including illegible or otherwise indiscernible content. Replacement Drawing Sheets including amended Figs. 1, 2, and 6 are submitted herewith in accordance with 37 C.F.R. § 1.121(d).

Specifically, the following drawing elements have been amended in order to provide clearly discernable features:

Fig. 1: element 118;

Fig. 2: element 118; and

Fig. 6: elements 602 and 604, and elements there within.

The Applicant asserts that amended Figs. 1, 2 and 6 fully address the objection raised by the Office and respectfully requests that such objection be withdrawn. The Applicant further asserts that no new matter has been submitted by way of the Replacement Drawing Sheets.

§ 101 Rejections

Claims 1-34 stand rejected under 35 U.S.C. § 101 because, in the Office's opinion, "the claims are not directed towards the final result that is useful, tangible and concrete" (page 2 of Office action). However, Applicant respectfully disagrees with the Office and submits that claims 1-34 fully and completely comply with the § 101 standard for patentable subject matter.

It is established law that an abstract idea, by itself, is considered to be unpatentable subject matter under § 101. See, e.g., AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1355 (1999)(pointing out that laws of nature, natural phenomena, and abstract ideas have generally been identified by the Supreme Court as unpatentable subject matter). However, if such an idea is taken out of the abstract and employed in a process that achieves a "new and useful end", the ***process is*** patentable subject matter, even if the idea by itself would not be. Id. at 1357. Thus, the relevant inquiry under § 101 becomes -- Is the idea being applied to achieve a useful end? Id. If so, then the § 101 threshold is satisfied. Id.

In AT&T, the invention was designed to operate in a telecommunications system with multiple long-distance service providers. The system contained local exchange carriers ("LECs") and long-distance service (interexchange) carriers ("IXCs"). The LECs provided local telephone service and access to IXCs. Each customer had an LEC for local service and selected an IXC, such as AT&T or Excel, to be its primary long-distance service (interexchange) carrier or PIC. The system involved a three-step process when a caller made a direct-dialed (1+) long-distance telephone call: (1) after the call was transmitted over the LEC's network to a switch, and the LEC identified the caller's PIC, the LEC automatically routed the call to the facilities used by the caller's PIC; (2) the PIC's facilities carried the call to the LEC serving the call recipient; and (3) the call recipient's LEC delivered the call over its local network to the recipient's telephone.

When a caller made a direct-dialed long-distance telephone call, a switch (which could be a switch in the interexchange network) monitored and recorded data related to the call and generated an "automatic message account" ("AMA") message record. This contemporaneous message record contained fields of information such as the originating and terminating telephone numbers, and the length of time of the call. These message records were then transmitted from the switch to a message accumulation system for processing and billing.

Because the message records were stored in electronic format, they could be transmitted from one computer system to another and reformatted to ease processing of the information. Thus the carrier's AMA message subsequently was translated into the industry-standard "exchange message interface," forwarded to a rating system, and ultimately forwarded to a billing system in which the data

resided until processed to generate, typically, "hard copy" bills which were mailed to subscribers.

The invention at issue in this case called for the addition of a data field into a standard message record to indicate whether a call involves a particular PIC (the "PIC indicator"). This PIC indicator could exist in several forms, such as a code which identified the call recipient's PIC, a flag which showed that the recipient's PIC was or was not a particular IXC, or a flag that identified the recipient's and the caller's PICs as the same IXC. The PIC indicator therefore enabled IXCs to provide differential billing for calls on the basis of the identified PIC.

One of the claims at issue – claim 1-- read as follows:

> A method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber, said method comprising the steps of:
>
> generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and
>
> including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers.

In looking at the subject matter of this claim and finding the claim to pass muster under 35 U.S.C. § 101, the Court looked to the *specification* and commented as follows:

> In this case, Excel argues, correctly, that the PIC indicator value is derived using a simple mathematical principle (p and q). But that is not determinative because AT&T does not claim the Boolean principle as such or attempt to forestall its use in any other application. It is clear from the written description of the '184 patent that AT&T is only claiming a process that uses the Boolean principle in order to determine the value of the PIC

indicator. The PIC indicator represents information about the call recipient's PIC, a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC's subscriber. Because the claimed process applies the Boolean principle to produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle, on its face the claimed process comfortably falls within the scope of § 101.

Here, the Court looked at the specification and found that the environment and use of the PIC indicator – that of providing differential billing – provided a useful, concrete and tangible result. That result, however, was not specifically recited in the claim. Rather, it was described in the specification.

Likewise, in the present case, the specification provides a description of the utility and tangibility of the recited subject matter. Specific sections of the specification are excerpted below to further illustrate this point:

> Implementations described and claimed herein solve the discussed problems, and other problems, by providing a document representation format to facilitate scalable web page structure. Web page content may be adapted to a display size by extracting information from the content in accordance with a layout optimization rule using a document representation structure in the web page definition.
>
> An exemplary system includes a browser to browse a web page based on a web page definition having a slicing tree defining an arrangement of rectangular regions in the web page. The web page definition can include parametric data describing adaptability parameters associated with a rectangular region. A proxy module generates an intermediary adapted web page definition and a rendering module renders the adapted web page based on the adapted web page definition.
>
> A method includes rendering the web page according to a slicing tree and block property data in an associated web page definition. The method may include determining a set of unsummarized blocks that maximize information fidelity. Specification at page 2, line 21 to page 3, line 11.

Accordingly, in this excerpt as throughout the document, it is evident that the claimed subject matter has a specifically described useful, concrete and tangible result and application.

In view of the above discussion, Applicant respectfully submits that claims 1-34 comply with the patentability requirements of § 101 and that the § 101 rejections should be withdrawn. The Applicant further asserts that claims 4-6, 9-10, 19-22 and 27-34 are allowable.

§ 103 Rejections

Claims 1-3, 7-8, 11-18 and 23-26 stand rejected under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent Application Publication No. 2004/0133927 ("Sternberg"), in view of U.S. Patent Application Publication No. 2004/0177316 ("Layzell").

The Claims

Claim 1 recites a method comprising (emphasis added):

- receiving ***a web page definition having a slicing tree describing an arrangement of a plurality of blocks in the web page***; and
- rendering the web page on a display screen according to the slicing tree.

In making out the rejection of this claim, the Office argues that its subject matter is disclosed by Sternberg in combination with Layzell. Applicant respectfully disagrees and traverses the Office's rejection. For the reasons set

forth below, the rejection over the combination of Sternberg and Layzell does not establish a prima facie case of obviousness.

First, the Office relies upon Sternberg for a disclosure (i.e., teaching) that in fact is not present. Thus, the combination of Sternberg and Layzell fails to teach or suggest at least one feature as positively recited in the claimed subject matter.

Second, the Office has failed to establish a proper motivation to combine Sternberg and Layzell. Each of these arguments will be addressed below under separate subheadings.

A. Sternberg and Layzell Fail to Disclose Claimed Subject Matter

The Office asserts that Sternberg fails to teach an arrangement of a plurality of blocks (page 4 of Office action). The Applicant agrees as to the foregoing deficiency of Sternberg. However, the Office further asserts that Sternberg teaches "receiving a web page definition having a slicing tree describing … in the web page". Respectfully, the Office is mistaken.

Specifically, Sternberg fails to teach a web page definition having a slicing tree describing an arrangement of a plurality of blocks in the web page, as recited by this claim. Specifically, Sternberg is directed to generation of a "visual key" for each frame (or other quantum) of a media object to be considered in various searching and image matching and/or comparison operations (Abstract; *et seq.* of Sternberg). Sternberg further teaches that the content of web pages can be considered as sources to be searched for matching images and textual information (Para. 0587 of Sternberg). However, Sternberg provides no teachings whatsoever

directed to the particular content of *web page definitions*, and certainly does not teach or suggest any such web page definition having (i.e., inclusive of) a slicing tree describing an arrangement of a plurality of block in the web page, as recited in the instant claim. While Sternberg refers to a "Decision Tree Slicing Value" (Para. 0567 of Sternberg), such is in the context of a threshold value for making a go/no-go comparison of statistical quantities – not the same as *describing an arrangement* as recited by claim 1.

In an attempt to overcome some of the deficiencies of Sternberg, the Office relies on Layzell. Respectfully, such reference to Layzell is not sufficient. Specifically, Layzell fails to teach or suggest a web page definition having a slicing tree describing an arrangement of a plurality of blocks in the web page, as recited by this claim. Specifically, Layzell is directed to composing page contents (for printing, etc.) by way of an iterative process so as to minimize the cost (i.e., area, etc.) required to present some or all the required objects (Abstract; *et seq.* of Layzell). Layzell does refer to content of such pages as "blocks" being of rectangular form (Paras. 0038 and 0039 of Layzell). Furthermore, Layzell teaches that such rectangles can be defined by way of a slicing structure (Para. 0040 of Layzell). Despite any particular teachings therein, Layzell is totally devoid of a *web page definition* having *a slicing tree describing an arrangement of a plurality of block in the web page*, as recited in claim 1.

Neither Sternberg nor Layzell are respectively concerned with *web page definitions* of any kind, and certainly not with the specificity as recited in the instant claim. Put another way, there is no way to select elements from Sternberg, and then to somehow combine those elements with other elements selected from

Layzell in order to arrive at the subject matter recited by claim 1, as no possible combination of Sternberg and Layzell teaches or suggest all of the required subject matter.

Accordingly, the Office's *prima facie* case of obviousness fails for at the least the reason that the combination of Sternberg and Layzell fails to teach or suggest all of the features recited in the claimed subject matter.

B. Improper Motivation to Combine

Assuming *arguendo* that Sternberg, when combined with Layzell, does teach all of the required features (which it does not), the Office has nevertheless failed to establish a sufficient motivation to combine Sternberg and Layzell.

Specifically, the Office states that the motivation to combine these references is established, at least in part, because such a combination "provides for an unlimited user interaction and to provide for a total minimized cost" (page 4 of Office Action). Applicant submits that this motivation is improper as neither Sternberg nor Layzell express any concern for a web page definition, or anything that it might include, anywhere within their respective teachings. Applicant respectfully reminds the Office that to establish a *prima facie* case of obviousness, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings***. See, e.g., *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Here, there is simply no suggestion or motivation in either of the references to support the modification – and in particular, the specifically required result - as argued by the Office.

Moreover, this motivation is lacking in the type of particularity that is required to make out a prima facie case of obviousness. That is, the Office's stated motivation is so general that it could serve as a motivation to modify Sternberg in any manner whatsoever, and ignores the need for particular support within the Layzell reference.

MPEP 2142 instructs, with regard to making out a rejection under §103 that "[t]he factual inquiry whether to combine references must be ***thorough and searching***." The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

In the present case, the "particular findings" that the Office relies upon are as follows: "provides unlimited user interaction and to provide for a total minimized cost". Applicant respectfully submits that the Office's stated motivation is not a "particular finding" sufficient to support a *prima facie* case of obviousness.

Accordingly, for at least these reasons, the Office's *prima facie* case of obviousness against claim 1 fails.

Claims 2-11 are allowable at least as depending from an allowable base claim.

Claim 12 recites a computer-readable medium having stored thereon computer-executable instruction for performing a method comprising (emphasis added):

- generating a ***web page definition*** having block property data defining a ***minimum perceptible size*** of a plurality of blocks in the web page.

In making out the rejection of this claim, the Office argues that its subject matter is disclosed by Sternberg in combination with Layzell. Applicant respectfully disagrees and traverses the Office's rejection. For the reasons set forth below, the rejection over the combination of Sternberg and Layzell does not establish a prima facie case of obviousness.

Specifically, Sternberg fails to teach or suggest generating a web page definition having block property data defining ***a minimum perceptible size*** of a plurality of blocks in the web page as recited by this claim. Again, Sternberg: 1) is not concerned with *web page definitions* in the first place; and 2) is completely lacking any teachings in regard to *a plurality of blocks in the web page*. Furthermore, Sternberg fails to teach or suggest any ***minimum perceptible size*** for a block, or any kind of property data defining such a characteristic.

In addition, Layzell fails to cure the deficiencies of Sternberg. More specifically, Layzell fails to teach or suggest generating a web page definition having block property data defining ***a minimum perceptible size*** of a plurality of blocks in the web page as recited by this claim. Layzell discusses dimensions related to rectangular content items (Para. 0039 of Layzell). However, Layzell does not teach or suggest property data defining minimum perceptible sizes for a plurality of blocks – or any other entities, for that matter.

Accordingly, for at least these reasons, the Office's *prima facie* case of obviousness against claim 12 fails.

Claims 13-16 are allowable at least as depending from an allowable base claim.

Claim 17 recites a processor-readable medium having processor-executable instructions for performing a method comprising (emphasis added):

- receiving a ***web page definition*** defining a plurality of blocks in a web page;
- determining a ***maximum information fidelity*** associated with a combination of ***summarized*** and ***unsummarized blocks*** in the web page; and
- rendering the web page with the combination of summarized and unsummarized blocks.

In making out the rejection of this claim, the Office argues that its subject matter is disclosed by Sternberg in combination with Layzell. Applicant respectfully disagrees and traverses the Office's rejection. For the reasons set forth below, the rejection over the combination of Sternberg and Layzell does not establish a prima facie case of obviousness. To help clarify this important point, attention is directed to page 20, lines 11-21 of the Specification as originally filed, which instructs as follows (emphasis added):

> In another implementation of block property data, an alternative version of a block is a summarized version of the block's contents, which is user selectable (e.g., hypertext). When the user selects the summarized version, a new web page, which is the size of the target area, is rendered that includes the non-summarized, or original version of the block contents. Thus, the original version of the block is allocated the entire target area, rather than being squeezed into what may be a relatively small region of the target area. Instead of deleting contents or showing an imperceptible adapted version, an alternative version enables users to see the whole in parts and can provide a much better solution to preserve contents, save

display space, and aid user navigation. If necessary (i.e., for very large content blocks), a scroll bar may be added to the original block.

Sternberg fails to teach or suggest determining a ***maximum information fidelity*** associated with a combination of ***summarized*** and ***unsummarized blocks*** in the web page as recited by this claim. Sternberg is lacking any teaching or suggestion related to summarized and unsummarized blocks in a web page as those terms are used in the present application and claim. Furthermore, Sternberg does not teach or suggest any sort of determination related to maximum information fidelity in regard to anything, and certainly not with respect to the subject matter of claim 17.

Furthermore, Layzell fails to cure the deficiencies of Sternberg. More specifically, Layzell fails to teach or suggest determining a ***maximum information fidelity*** associated with a combination of ***summarized*** and ***unsummarized blocks*** in the web page as recited by this claim. Layzell provides no teaching or suggestion related to summarized and/or unsummarized blocks, nor does Layzell teach or suggest any sort of maximum information fidelity in regard to blocks in a web page, or anything else. To the contrary, Layzell is concerned with determining a page layout inclusive of some or all of a number of predetermined objects, and does not consider or suggest combinations of summarized and unsummarized content (i.e., blocks) within a web page as recited in this claim (Para. 0002 of Layzell).

It is not possible to combine features selectively taken from Sternberg and Layzell so as to arrive at the subject matter recited by claim 17, as no possible combination of Sternberg and Layzell teaches or suggest all of the required

features. Accordingly, for at least these reasons, the Office's *prima facie* case of obviousness against claim 17 fails.

Claims 18-22 are allowable at least as depending from an allowable base claim.

Claim 23 recites a system comprising (emphasis added):

- a browser operable to browse a web page based on a ***web page definition comprising a slicing tree defining an arrangement of a plurality of rectangular regions in the web page***.

In making out the rejection of this claim, the Office argues that its subject matter is disclosed by Sternberg in combination with Layzell. Applicant respectfully disagrees and traverses the Office's rejection. For the reasons set forth below, the rejection over the combination of Sternberg and Layzell does not establish a prima facie case of obviousness.

The Applicant asserts that this claim is allowable at least for reasons analogous to those argued above in regard to claim 1. Specifically, Sternberg fails to teach or suggest a web page definition comprising a slicing tree defining an arrangement of a plurality of rectangular regions in the web page, as recited by this claim.

Layzell fails to cure the deficiencies of Sternberg. Specifically, Layzell fails to teach or suggest a web page definition comprising a slicing tree defining an arrangement of a plurality of rectangular regions in the web page, as recited by this claim.

Accordingly, for at least these reasons, the Office's *prima facie* case of

obviousness against claim 23 fails.

Claims 24-27 are allowable at least as depending from an allowable base claim.

Conclusion

All of the claims 1-34 are in condition for allowance. Accordingly, Applicant requests a Notice of Allowability be issued forthwith. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully Submitted,

Dated: 8/15/06

By: _____

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